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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,705	12/09/2003	Timothy J. Wojcik	86236WRZ	5248

7590 05/31/2005

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EXAMINER

COLILLA, DANIEL JAMES

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/731,705

Applicant(s)

WOJCIK ET AL.

Examiner

Daniel J. Colilla

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,7-9,12,14,17,18 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-9 and 18 is/are allowed.
- 6) ☒ Claim(s) 1,12,14,17 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of original claims 11-14 (the indicated allowed subject matter now incorporated into claims 1 and 17) is withdrawn in view of case law that has recently been brought to the attention of the examiner. Rejections based on this case law follow.
2. Claims 7-9 and 18 are allowed.

Claim Objections

3. Claims 17 and 24 are objected to because of the following informalities: in claim 17, "the printhead," "the carrier removal station" and "the converting station" have no antecedent basis in the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al. (US 6,513,924).

With respect to claim 1, Goldberg et al. discloses the claimed system for printing and treating a recording element except for the printhead being located in a first unit and

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the carrier removal station and converting station being located in a second unit.

Goldberg et al. discloses a printhead 64 for dispensing a liquid ink comprising a carrier (water). Goldberg et al. further discloses a carrier removal station 70 (col. 6, lines 36-41) which removes a portion of the carrier from the recording element 62. While Goldberg et al. does not explicitly recite that a predetermined percentage of carrier is removed, it is inherent in the design of the system that the carrier removed be within an adequate, predetermined range that achieves the desired function without removing too much carrier and causing damage to the recording element. Col. 6, lines 61-67 and col. 7., lines 1-7 of Goldberg et al. disclose how various aspects of the system are controlled in order to evaporate a desired amount of the carrier. Also disclosed by Goldberg et al. is a converting station 72,74 positioned downstream of the carrier removal station 33, which increases the recording element's durability by applying a binder (Goldberg et al., col. 6, lines 42-50).

Figures 3 and 5 of Goldberg et al. show the system 60 as a single unit. However, it has been held that making structure separable is an obvious modification (see *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961); MPEP§ 2144.04, part V, C.). In this case it would have been obvious to separate the printhead 64 into a first unit from a second unit containing the carrier removal station 70 and the converting station 72,74 in order to allow easier transport and positioning of the apparatus.

With respect to claim 12, the first unit is capable of being positioned over the second unit just as any object could be put over another object.

With respect to claim 17, Goldberg et al. discloses a recording element printing and treating method including the steps of printing a liquid on a recording element with a

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printhead 64 for dispensing a liquid ink comprising a carrier (water). Goldberg et al. further discloses a removing a predetermined percentage of carrier with a carrier removal station 70 (col. 6, lines 36-41) which removes a portion of the carrier from the recording element 62. While Goldberg et al. does not explicitly recite that a predetermined percentage of carrier is removed, it is inherent in the design of the system that the carrier removed be within an adequate, predetermined range that achieves the desired function without removing too much carrier and causing damage to the recording element. Col. 6, lines 61-67 and col. 7., lines 1-7 of Goldberg et al. disclose how various aspects of the system are controlled in order to evaporate a desired amount of the carrier. Also disclosed by Goldberg et al. is a step of increasing a durability characteristic of the recording element with binding and heating devices 72 and 74 respectively (Goldberg et al., col. 6, lines 42-50). The step of increasing the durability with devices 72 and 74 is distinct from the step of removing a carrier with heating device 70.

Figures 3 and 5 of Goldberg et al. show the system 60 as a single unit. However, it has been held that making structure separable is an obvious modification (see *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961); MPEP§ 2144.04, part V, C.). In this case it would have been obvious to separate the printhead 64 into a first unit from a second unit containing the carrier removal station 70 and the converting station 72,74 in order to allow easier transport and positioning of the apparatus.

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al. as applied to claims 1, 12 and 17 above, and further in view of Zach et al. (US 2005/0067523).

Goldberg et al. in view of *In Re Dulberg* discloses the claimed system except for the media handling mechanism. However, Zach et al. discloses a media handling mechanism as shown in Figure 1 of Zach et al. It would have been obvious to combine the teaching of Zach et al. with the system disclosed by Goldberg et al. for the advantage of directing the recording element in the appropriate direction in the event that the first and second units are not directly adjacent one another but are arranged at angles to one another.

7. Claims 17 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Jurrens et al. (US 6,679,599).

With respect to claim 17, Jurrens et al. discloses a recording element printing and treating method including the steps of printing a liquid 94 comprising a carrier onto a recording element 106 as shown in Figure 1 of Jurrens et al. Further disclosed is a step of removing a predetermined percentage of carrier present in the recording element 106 with heated roll 100. While Jurrens et al. does not explicitly recite that a predetermined percentage of carrier is removed, it is inherent in the design of the system that the carrier removed be within an adequate, predetermined range that achieves the desired function without removing too much carrier and causing damage to the recording element. Jurrens et al. also discloses a step of increasing a durability characteristic of the recording element 106 by coating it with a thermal transfer overcoat material 12 and passing the recording element between two rollers 100 and 116. This step is separate from the step of removing the carrier as is shown by the insertion of the recording element 106 into different slots 102 and 104.

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Figure 1 of Jurrens et al. shows the carrier removal station (heated roll 100) and the converting station (100,112,116) together in one unit, but it is not clear if the printhead 89 is in a separate unit or not. In the case that it is not, it has been held that making structure separable is an obvious modification (see *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961); MPEP§ 2144.04, part V, C.). In this case it would have been obvious to separate the printhead 89 into a first unit from a second unit containing the carrier removal station 100 and the converting station 100,112,116 in order to allow easier transport and positioning of the apparatus.

With respect to claim 24, the step of increasing the durability characteristic of the recording element includes applying pressure to the recording element 106 with rolls 100 and 116 as shown in Figure 1 of Jurrens et al.

Response to Arguments

8. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Since this is a new grounds of rejection not required by applicant's amendment this action is non-final.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Colilla whose telephone number is (571) 272-2157. The examiner can normally be reached Mon.-Thur. between 7:30 am and 5:00 pm. Faxes regarding this application can be sent to (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached at (571) 272-2168. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 26, 2005


Daniel J. Collilla
Primary Examiner
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